



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,700	11/12/2003	Edward D. Riley	16432-0042P1	8582

24267 7590 03/23/2007
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
----------	--------------

1744

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/706,700	Applicant(s) RILEY, EDWARD D.	
	Examiner MONZER R. CHORBAJI	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months' after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This non-final action is in response to the RCE/Amendment received on 01/23/2007

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not teach or show thin-walled sleeves. For example, the walls of sleeves, 54, in figure 4 are not thin.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1, 10 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 10 and 18 recite the limitations "thin-walled tubes" or "thin-walled sleeves". However, the disclosure does teach measurements for the walls of the tubes and sleeves where the examiner is able to construe the meaning of thin and one of ordinary skill in the art upon reading the specification would not be able to understand

what "thin" represents since there is no standard in the art to which "thin" can be compared to.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al (U.S.P.N. 5,108,287) in view of Genis (U.S.P.N. 4,050,894).

Regarding claim 1, Yee discloses a dental tray assembly (figure 2:12 and 10) that includes the following: a unitary molded plastic base (figure 2:10 and col.3, lines 3-5), a plurality of individual tubes defining first passages (unlabeled inner volume of each individual tube in figure 4) having open lower and upper ends (figure 4:unlabeled tubes), first web (figure 2:14, 16, 18 and 20) with a periphery connecting and supporting the tubes, instrument supports at the lower ends of the first passages (unlabeled bottoms of tubes in figure 4 are capable of supporting dental instruments) and a unitary molded

Art Unit: 1744

plastic cover for the base (figure 2:-12). In addition, a sterilizing fluid when injected into orifices 44 of figure 2 and circulated through drainage passages 24 in figure 2 is capable of circulating around (for example, steam moves from one of the orifices 44 in a circle down one of the unlabeled tubes in figure 4 and out from drainage passage 24) and between (for example, steam moves between the tops of vertical orifices 22 in figure 2) the tubes from the first web to the lower ends of the first passages. While, Yee's tubes are not specifically taught to be separated by space and not to have thin walls, Genis's sterilization tray includes individually thin-walled (see the thin walls of tube 57 in figure 6) spaced apart tubes (figure 7:57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create spaces between Yee's individual tubes as taught by Genis so that openings in the walls of each individual tube are made to enable sterilant to circulate freely within each tube (Genis, col.6, lines 13-16).

Regarding claims 2-6 and 8, Yee teaches the following: the upper ends of the first passages are flared (unlabeled flared upper ends of the passages in figure 4), base and cover include interfitting latching surfaces (figures 2 and 5 where surface 14 of the base and unlabeled opposite surface of the cover interfit and col.3, lines 3-23), first web (figure 2:14, 16, 18 and 20) includes a top wall (figure 2:14) of the base (figure 2:10) and includes a peripheral web extending down from the first web and spaced around the plurality of tubes (figure 2:16 and unlabeled opposite side walls of the base 10), peripheral web includes a side wall of the base (figure 2:18), first web includes a top web (figure 2:14), one or more receptacles in the tray wall (figure 2:22) and bridges at

the lower ends of the first passages that partially occlude the lower ends of the tubes (unlabeled bottom curving surfaces of the unlabeled tubes in figure 5).

8. Claims 10-13 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al (U.S.P.N. 5,108,287) in view of Genis (U.S.P.N. 4,050,894) and further in view of Friedman (U.S.P.N. 3,248,167).

Regarding claim 18, Yee discloses a dental tray assembly (figure 2:12 and 10) that includes the following: a unitary molded plastic base (figure 2:10 and col.3, lines 3-5), top wall (figure 2:14), a plurality of individual tubes extending downward from top wall having open lower and upper ends (figure 4:unlabeled tubes), a periphery wall extending downward from the top wall (figure 2:16 and 18) being spaced from the surrounding tubes (unlabeled spaces between 16, 18 and unlabeled tubes in figure 4) and instrument supports at the lower ends of the plurality of first passages (unlabeled bottoms of tubes in figure 4 are capable of supporting dental instrument). Furthermore, Yee teaches a molded plastic cover for the base (figure 2:12 and col.3, lines 3-5) that includes the following: a top wall (unlabeled top wall of 12 in figure 2), a sleeve extending down from the top wall of the cover in parallel spaced-apart relation (unlabeled inner walls of 36 and 38 in figure 5), sleeve defining second passage (unlabeled space contained between 36 and 38 of figure 5) that is open at the bottom (unlabeled open bottom of unlabeled space in figure 5) and the top (figure 5:44), lower end of the sleeve has substantially the same cross-section as the upper end of the first passages (unlabeled space contained between 36 and 38 and unlabeled tube in figure 5) and a peripheral wall extending down from the top wall of the cover so as to surround

the sleeve (figure 5:36 and 38). While, Yee's tubes are not specifically taught to be separated by space nor to have thin walls or the use of more than one individual sleeve, Genis's sterilization tray includes individually thin-walled (see the thin walls of tube 57 in figure 6) spaced apart tubes (figure 7:57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create spaces between Yee's individual tubes as taught by Genis so that openings in the walls of each individual tube are made to enable sterilant to circulate freely within each tube (Genis, col.6, lines 13-16).

Genis's cover does not include having individual sleeves; however, Friedman's dental burr holder includes a cover with plurality of individual sleeves (figure 2:5, 14 and 16). Upon providing Friedman teachings of placing individual sleeves in the plastic molded cover of Yee device, passages in both of the base and the top of Yee device are co-linear and continuous. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the one large passage in the cover of Yee's assembly with individualized sleeves as taught by Friedman so that stems of burrs are accommodated (Friedman, col.1, lines 49-52).

Regarding claims 10 and 12, Yee teaches a plastic molded cover for the base (figure 2:12 and col.3, lines 3-5) that includes the following: a top wall (unlabeled top wall of 12 in figure 2), a sleeve extending down from the top wall of the cover in parallel spaced-apart relation (unlabeled inner walls of 36 and 38 in figure 5), sleeve defining second passage (unlabeled space contained between 36 and 38 of figure 5) that is open at the bottom (unlabeled open bottom of unlabeled space in figure 5) and the top

(figure 5:44), lower end of the sleeve has substantially the same cross-section as the upper end of the first passages (unlabeled space contained between 36 and 38 and unlabeled tube in figure 5), a peripheral wall extending down from the top wall of the cover so as to surround the sleeve (figure 5:36 and 38), a second web (unlabeled lower ends of 38 and 36 in figure 5 that interfit with the top surface of the base) having a periphery and connecting the sleeve (unlabeled inner walls of 36 and 38 in figure 5) and the upper ends of the second passage is smaller than the lower end of the second passage (unlabeled distance of the upper end and the lower end of the unlabeled space in figure 5 between 36 and 38). While Yee's individual sleeve is not specifically taught to have thin walls or to have more than one individual sleeve, Genis's sterilization tray includes individually thin-walled (see the thin walls of tube 57 in figure 6) spaced apart tubes (figure 7:57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create spaces between Yee's individual tubes as taught by Genis since the thin walls of each tube allows openings to be made easily in order to enable sterilant to circulate freely within it (Genis, col.6, lines 13-16).

Genis's cover does not include having individual sleeves; however, Friedman's dental burr holder includes a cover with plurality of individual sleeves (figure 2:5, 14 and 16). Upon providing Friedman teachings of placing individual sleeves in the plastic molded cover of Yee device, passages in both of the base and the top of Yee device are co-linear and continuous. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the one large passage in

Art Unit: 1744

the cover of Yee's assembly with individualized sleeves as taught by Friedman so that stems of burrs are accommodated (Friedman, col.1, lines 49-52).

Regarding claims 11 and 13, Yee teaches that the second passage is longer than the first passage (unlabeled space contained between 36 and 38 of figure 5 and unlabeled first passage from the left side in figure 4) and that the cross-section of the second passage is larger than the first passage (cross section of the unlabeled space contained between 36 and 38 of figure 5 and cross section of the unlabeled first passage from the left side in figure 4). While Yee's individual sleeve is not specifically taught that it can be separated into multiple individual sleeves; however, Friedman's dental burr holder includes a cover with plurality of individual sleeves (figure 2:5, 14 and 16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the one large passage in the cover of Yee's assembly with individualized sleeves as taught by Friedman so that stems of burrs are accommodated (Friedman, col.1, lines 49-52).

Regarding claim 17, the sidewall of the base (figure 2:10 and 16) of the tray assembly of Yee has a lower edge (figure 2:20) spaced below the lower ends of the first passages (unlabeled bottom portions of tubes in figure 4).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al (U.S.P.N. 5,108,287) in view of Genis (U.S.P.N. 4,050,894) as applied to claim 5 and further in view of Rose (U.S.P.N. 6,328,565).

Both Yee and Genis fail to teach placing indicia on the top wall for indicating the contents of the base. Rose teaches placing indicia on his dental holder (see figure 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place indicia on the tray of Yee device so that persons can readily learn and/or become accustomed to the bur characteristics so that bur identification in the future is made easier (Rose, see abstract).

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al (U.S.P.N. 5,108,287) in view of Genis (U.S.P.N. 4,050,894) as applied to claim 1 and further in view of Kazen et al (U.S.P.N. 4,253,830).

Both Yee and Genis fail to teach placing interior flanges at the lower ends of the tubes; however, Kazen teaches in figure 4 where unlabeled flanges in the lower region of receptacle 28 holds bur FG. Clearly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the lower region of the tubes in the tray of Yee device so that different types of bur devices can be supported and sterilized in Yee's tray assembly.

11. Claims 14-16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al (U.S.P.N. 5,108,287) in view of Genis (U.S.P.N. 4,050,894), Friedman (U.S.P.N. 3,248,167) as applied to claims 10 and 18 and further in view of Brewer (U.S.P.N. 4,959,199).

Regarding claims 14-16 and 19-21, Yee discloses a dental tray assembly (figure 2:12 and 10) that includes the following: a first web (figure 2:14, 16, 18 and 20) having a top wall (figure 2:14) of the base (figure 2:10), the base includes a side wall extending down from the top wall of the base (figure 2:16), second web (unlabeled web that constitute the cover 12 in figure 2) having a top wall (unlabeled surface of the cover that

interfit with the top surface of the base) of the cover (unlabeled top wall of 12 in figure 2), the cover includes a side wall extending down from the top wall of the cover (unlabeled cover of legs 30 in figure 2). However, Yee, Genis and Friedman all do not specifically teach using first keying and second keying surfaces. Brewer's sterilization tray assembly includes dental cassettes with various first and second keying surfaces (unlabeled first and second keying surfaces in figure 1 or 56 and unlabeled second keying surfaces in figure 13) distributed around the peripheries of both the top and bottom portions of the containers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add first and second keying surfaces to the dental tray assembly of Yee so that accidental opening of the tray assembly during handling is prevented upon inclusion of this additional closing mechanism.

Response to Arguments

12. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

On bottom of page 3 into page 4 of the Remarks section, Applicant argues no teaching is provided in Yee or in Friedman that the individual sleeves are arranged and adopted to mate with the corresponding tubes in the base. In figure 4 of Yee, the individual unlabeled sleeve in figure 5 does meet and cooperate with the tubes in the base portion. Additionally, the combination of Yee and Friedman is capable of arranging individual sleeves to cooperate with the corresponding tubes in the bas. See MPEP 2114.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 9:00-5:30.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GLADYS J. CORCORAN can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRC


GLADYS J. CORCORAN
SUPERVISORY PATENT EXAMINER